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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,540	08/23/2001	Mark Kirkpatrick	00584	8674

26285 7590 09/03/2003

KIRKPATRICK & LOCKHART LLP  
535 SMITHFIELD STREET  
PITTSBURGH, PA 15222

EXAMINER
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LE, KAREN L

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 09/03/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/935,540

Applicant(s)

KIRKPATRICK, MARK

Examiner

Karen Le

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Tatchell et al. (U.S. 6,160,877).

Regarding claims 1, 11, 13 and 19 Tatchell teaches in a telecommunication system and apparatus (Fig. 1, item 10) configured to provide a connection between a caller (Fig. 1, item 22) and a callee (fig. 1, item 17a) via a telephone network, wherein the telephone network is configured to connect the caller and the callee, a method for allowing the callee to prevent the caller from establishing the connection with the callee, the method comprising:

receiving an instruction from the callee to prevent the caller from establishing the connection with the callee (col. 19, lines 50-52);

identifying a first telephone number associated with the caller (Col. 23, lines 41-44); and  
preventing one or more phone calls from the first telephone number from being forwarded to a second telephone number associated with the callee (Col. 19, lines 53-67).

Regarding claims 2, 12, 14, 20, Tatchell further teaches receiving an instruction from the callee includes: detecting an off-hook signal from callee; and receiving a predetermined code from the callee (Col. 19, lines 33-41 and Col. 2, lines 16-19).

Regarding claim 3, Tatchell further teaches predetermined code includes at least one of the following:

one or more digits; and one or more non-numeric symbols (Col. 2, lines 15-19).

Regarding claim 4, Tatchell further teaches identifying the first telephone number includes maintaining a record of the most recent telephone number that was a source of a call placed to the second telephone number immediately prior to receiving the callee's instruction to prevent the caller from establishing the connection with the callee, and consulting the record to identify the most recent telephone number as the first telephone number (Col. 19, lines 28-52).

Regarding claim 5, Tatchell further teaches receiving the predetermined code includes: receiving a first portion of the predetermined code, prompting the callee to send a second portion of the predetermined code; and receiving the second portion of the predetermined code (Col. 2, lines 16-19).

Regarding claim 6, Tatchell further teaches providing a database to allow the callee to enter the first telephone number therein, wherein the database includes one or more telephone numbers to be blocked (Fig. 5b and Col. 19, lines 11).

Regarding claims 7-9, Tatchell further teaches prompting the callee to perform administration tasks (Col. 19, lines 39-41).

prompting the callee to record a message to be played to the caller, to select a pre-recorded message to be played to the caller (Col. 19, lines 65-67).

Regarding claim 10, Tatchell further teaches charging a subscription fee to the callee and charging a per-usage fee to the callee (Col. 1, lines 20-21).

Regarding claim 15, Tatchell further teaches comprising a database (Fig. 1, item 19) in communication with the controller (Fig. 1, item 16).

Regarding claim 16, Tatchell further teaches an interactive voice response system (Fig. 1, item 11) in communication with the controller (Fig. 1, item 16) and the switch (Fig. 1, item 10).

Regarding claim 17, Tatchell further teaches comprising a service creation computer in communication with the controller (fig. 1, item 10).

Regarding claim 18, Tatchell further teaches the switch is in communication with at least one of the first telecommunications device and the second telecommunications device via at least one of a public switched telephone network (Fig. 1, item 10) and an integrated services digital network (Fig. 1, item 10 and Fig. 8a, item 88).

*Conclusion*

3. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Or faxed to:

Hand-delivered responses should be brought to  
Crystal Park II, Sixth Floor (Receptionist)  
2121 Crystal Drive  
Arlington, VA 22202


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Le whose telephone number is 703-308-4998. The examiner can normally be reached on Monday - Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

Karen Le

KLL  
August 25, 2003

  
JACK CHIANG  
PRIMARY EXAMINER